

REMARKS/ARGUMENTS

Claims 1-11 are pending. Claim 1 has been amended to include limitations from Claims 2 and 7. Support for this amendment is also found in the specification on page 4, e.g., lines 14-17. Claims 2 and 7 have been amended to further limit Claim 1. Minor editorial revisions have been made to many claims and Claims 12-13 find support on page 4, lines 9-12 of the specification. Accordingly, no new matter has been introduced.

The Applicants thank Examiner Nguyen for the helpful discussion of November 1, 2005. It was suggested that the Applicants file a certified English translation of their foreign priority document to avoid the rejections based on Walsdorff et al. and by pointing out support for the invention in their priority document. Possible ways to further distinguish the claimed invention from the other prior art were discussed.

Rejections—35 U.S.C. §102(e) and 103(a)

Claims 1-6, 8 and 9 were rejected under 35 U.S.C. 102(e) as being anticipated by, and Claims 1-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over, Walsdorff et al., US 2004/0052718. These rejections are moot in view of the attached certified English translation of the foreign priority document DE 10221802. Support for the present invention may be found throughout the priority document—see e.g., the claims and page 4 of the English translation.

Rejections—35 U.S.C. §102 and 103

Claims 1-6, 8 and 9 were rejected under 35 U.S.C. 102(b) as being anticipated by, and Claims 1-5 and 7-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over, Johnson et al., U.S. Patent No. 2,542,961. These rejections are traversed, since Johnson does not disclose, suggest, or provide a reasonable expectation of success, for a method in which the

reacted hydrogen chloride is recirculated and the proportion of recirculated hydrogen chloride is gradually increased during the time of operation of the catalyst. As discovered by the inventors, these steps provide for a superior process, for example, one in which the operating life of the catalyst is increased (specification, page 4, lines 14-17).

Johnson does not disclose all the process steps required by Claim 1 and therefore cannot anticipate the present claims.

Johnson does not suggest or provide a reasonable expectation of success for the present invention and the benefits achieved by it, such as increased catalyst life and thus does not render the claimed invention obvious. The Official Action suggests that it would have been obvious to optimize the process conditions by routine experimentation. However, the prior art does not disclose that the process steps required by Claim 1 are "results-effective" variables. Only results-effective variables may be optimized and a particular parameter must first be recognized as a result-effective variable before the determination of the optimum of workable ranges of the variable might be characterized by routine experimentation, see MPEP 2144.05 (II)(B).

On the other hand, the present inventors have discovered that the activity of the catalyst decreases, but that by gradually increasing the recirculated hydrogen chloride during the time of operation that a nearly constant yield can be achieved over a prolonged period.

Since Johnson does not disclose that the process steps required by Claim 1 are results-effective variables, it provides no motivation for including these process steps, or a reasonable expectation of success for the benefits of attained by the process steps of the invention. Therefore, these rejections may now be withdrawn.

Rejection—35 U.S.C. §102

Claims 1-6, 8 and 9 were rejected under 35 U.S.C. 102(b) as being anticipated by Benson et al., U.S. Patent No. 5,639,436. Benson does not anticipate Claim 1 as presently amended, because it does not disclose a process in which the unreacted hydrogen chloride is recirculated and the proportion of recirculated hydrogen chloride is gradually increased during the time of operation of the catalyst. Accordingly, this rejection may now be withdrawn.

Rejection—35 U.S.C. §102

Claims 1-6, 8 and 9 were rejected under 35 U.S.C. 102(b) as being anticipated by GB 1,046,313. This patent does not anticipate Claim 1 as presently amended, because it does not disclose a process in which the unreacted hydrogen chloride is recirculated and the proportion of recirculated hydrogen chloride is gradually increased during the time of operation of the catalyst. Accordingly, this rejection may now be withdrawn.

CONCLUSION

In view of the above amendments and remarks, the Applicants respectfully submit that this application is now in condition for allowance. Early notification to that effect is earnestly solicited.

Respectfully submitted,

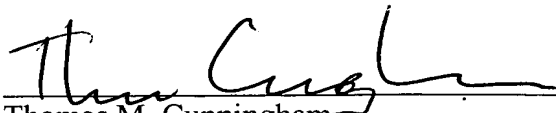
OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

NFO:TMC\law


Thomas M. Cunningham
Registration No. 45,394